



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Ronald Pasqualini

Appln. No.: 09/164,216

Filed: September 30, 1998

For: ESD PROTECTION CIRCUIT
UTILIZING FLOATING LATERAL
CLAMP DIODES

Group Art Unit: 2811

Examiner: O. Nadav

RESPONSE TO RESTRICTION
REQUIREMENT (Mailed May 1, 2001)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the
United States Postal Service postage prepaid in an envelope,
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Washington D.C. 20231-9999 on 05-09-01.

Commissioner for Patents
Washington, D.C. 20231Dated: 05-09-01By: Devin D. King

Dear Sir:

The Examiner stated that claims 1, 5-6, 10-11, 15, 17-21 and 33 (the cited claims) which read on the embodiment of FIG. 16 are further restricted as follows: The inventions of the embodiment of FIG. 16 and the embodiments of FIGs. 8-9 and 10-11 are related as combination and sub-combination.

A restriction is proper if the Examiner can show that (A) the inventions are independent or distinct; and (B) there is a serious burden on the Examiner if restriction is not required. If a search and examination of an entire application can be made without serious burden, the Examiner must examine the application on the merits, even though it includes claims to independent or distinct inventions. MPEP §803.

Applicant, however, has been unable to find any discussion in the restriction requirement wherein the Examiner set forth the reasons that a serious burden would be placed on the Examiner if restriction is not required. Since the Examiner has not set forth the reasons that a serious burden would be placed on the Examiner if restriction is not required, the Examiner has failed to set forth a proper restriction requirement.

Applicant notes that a serious burden on the Examiner may be prima facie shown if the Examiner shows by appropriate explanation either separate classification, separate status

in the art, or a different field of search. The prima facie showing, however, can be rebutted by the applicant. MPEP §803.

In the present case, the Examiner has already performed a search and examined all of the cited claims. As noted above, if a search and examination can be made without a serious burden, the Examiner must examine the application on the merits even though it includes claims to independent or distinct inventions. MPEP §803. Thus, since the Examiner has already performed a search and examined all of the cited claims, a serious burden no longer exists for the Examiner if restriction is not required.

Further, the Examiner can not satisfy the "serious burden" standard by merely showing that some additional work will be required to continue examination of the cited claims. (If the serious burden standard could be met by merely showing that some additional work was required, the requirement would be effectively eliminated as some additional work would always be required.)

Thus, absent any explanation of why the Examiner would face a serious burden to continue examination, the Examiner has failed to set forth a proper restriction requirement. (Applicant does not believe any election is required as the Examiner has failed to set forth a proper restriction requirement. However, should an election be required, applicant elects to prosecute the embodiment shown in FIG. 16 with the above traversal.)

The Examiner also stated that the application contains claims 1, 5-6, 10-11, 15, 17-21 and 33 (the noted claims) which are directed to the following patentably distinct species of the claimed subcombination:

1. Embodiment of figures 8-9; and
2. Embodiment of figures 10-11.

As a result, applicant elects the embodiment of figures 10-11 with traverse. From what applicant can determine, figures 10-11 (and also figures 8-9) do not illustrate all of the limitations required by claims 1, 5-6, 10-11, 15, 17-21 and 33. Thus, it appears that none of the noted claims read on the embodiment shown in figures 10-11 (or figures 8-9).

Applicant traverses this requirement on the following grounds. In the prior office action, the Examiner asserted that claims 1, 5-6, 10-11, 15, 17-23, and 32-37 are directed to a number of patentably distinct species. The Examiner identified six species, and argued that

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FIGs. 8-9, 10-11, 12, 14, 15, and 16 each show a different species. In response, applicant elected to prosecute the embodiment shown in FIG. 16.

Having elected to prosecute the embodiment disclosed in FIG. 16, and not electing to prosecute the embodiment disclosed in FIGs. 8-9 or FIGs. 10-11, the Examiner may not ignore applicant's election and require applicant to elect between two of the other six embodiments identified by the Examiner.

Respectfully submitted,

PILLSBURY WINTHROP LLP

Dated: 5-9-01By: 

Mark C. Pickering
Registration No. 36,239

Attorney for Assignee

50 Fremont Street, Fifth Floor
San Francisco, CA 94105-2228
Direct Dial Telephone No. (415) 983-1297
Telephone: (415) 983-1000
Facsimile: (415) 983-1200